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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/037,390	10/23/2001	Timothy J. Wilkinson	40.0010 C1	7729

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SCHLUMBERGER AUSTIN TECHNOLOGY CENTER  
ATTN: PEHR B. JANSSON, INTELLECTUAL PROP LAW DEPT.  
8311 NORTH FM 620  
AUSTIN, TX 78726

[REDACTED] EXAMINER

CHAVIS, JOHN Q

[REDACTED] ART UNIT [REDACTED] PAPER NUMBER

2124

DATE MAILED: 09/24/2003

12

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	10/037,390	WILKINSON ET AL.
	Examiner John Q. Chavis	Art Unit 2124
<i>-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --</i>		
<b>Period for Reply</b>		
<b>A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.</b>		
<ul style="list-style-type: none"> <li>- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.</li> <li>- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.</li> <li>- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.</li> <li>- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).</li> <li>- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).</li> </ul>		
<b>Status</b>		
1) <input checked="" type="checkbox"/> Responsive to communication(s) filed on <u>17 April 2003 and 07 July 2003</u> .		
2a) <input type="checkbox"/> This action is <b>FINAL</b> .      2b) <input checked="" type="checkbox"/> This action is non-final.		
3) <input type="checkbox"/> Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under <i>Ex parte Quayle</i> , 1935 C.D. 11, 453 O.G. 213.		
<b>Disposition of Claims</b>		
4) <input checked="" type="checkbox"/> Claim(s) <u>106-149</u> is/are pending in the application.		
4a) Of the above claim(s) _____ is/are withdrawn from consideration.		
5) <input type="checkbox"/> Claim(s) _____ is/are allowed.		
6) <input checked="" type="checkbox"/> Claim(s) <u>106-118, 120-128, 130-143, 145, 147 and 149</u> is/are rejected.		
7) <input checked="" type="checkbox"/> Claim(s) <u>119, 129, 144, 146 and 148</u> is/are objected to.		
8) <input type="checkbox"/> Claim(s) _____ are subject to restriction and/or election requirement.		
<b>Application Papers</b>		
9) <input type="checkbox"/> The specification is objected to by the Examiner.		
10) <input type="checkbox"/> The drawing(s) filed on _____ is/are: a) <input type="checkbox"/> accepted or b) <input type="checkbox"/> objected to by the Examiner. Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).		
11) <input type="checkbox"/> The proposed drawing correction filed on _____ is: a) <input type="checkbox"/> approved b) <input type="checkbox"/> disapproved by the Examiner. If approved, corrected drawings are required in reply to this Office action.		
12) <input type="checkbox"/> The oath or declaration is objected to by the Examiner.		
<b>Priority under 35 U.S.C. §§ 119 and 120</b>		
13) <input type="checkbox"/> Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f). a) <input type="checkbox"/> All b) <input type="checkbox"/> Some * c) <input type="checkbox"/> None of: 1. <input type="checkbox"/> Certified copies of the priority documents have been received. 2. <input type="checkbox"/> Certified copies of the priority documents have been received in Application No. _____. 3. <input type="checkbox"/> Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)). * See the attached detailed Office action for a list of the certified copies not received.		
14) <input checked="" type="checkbox"/> Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application). a) <input type="checkbox"/> The translation of the foreign language provisional application has been received.		
15) <input type="checkbox"/> Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.		
<b>Attachment(s)</b>		
1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)		
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)		
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____		
4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____		
5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)		
6) <input type="checkbox"/> Other: _____		

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### **DETAILED ACTION**

1. The applicant's desire for claim grouping is acknowledged. However, all of the claims are considered to stand or fall together by the examiner. The features cited by the applicant in reference to Group III is considered the most specific group; which, encompasses the features of groups I and II. The specific features in Group III were added in the previous application (6,308,317) to make the claims allowable over the art of record, which was cited for Groups I and II. Furthermore, the features of Group II is merely a more specific version of the Group I claims. Therefore, all groups are considered to stand or fall together and the double patenting is considered pertinent to all of the claims.

#### *Specification*

2. The disclosure is objected to because of the following informalities: appendices larger than ten pages in length should be submitted on cd-rom.

Appropriate correction is required.

#### *Claim Rejections - 35 USC § 103*

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 106-118, 120-128, 130-143, 145, 147 and 149 are rejected under 35 U.S.C. 103(a) as being unpatentable over Peyret (5,923,884) as applied in the previous action, and further in view of Renner et al. (5,679,945). The applicant claims a microcontroller with a memory for

storing information for communicating with a terminal. The applicant's reply, dated 4-17-03 and 7-7-03, appears to be focused on the converting feature. The features of the applicant's claim are now presented in a side-by-side manner with the teachings of Peyret in view of Renner.

What is claimed is:

106. A microcontroller for use with a terminal, comprising:

a memory storing: a derivative application derived from an application having a class file format by first compiling the application having a class file format into a compiled form and then converting the compiled form into a converted form, and

And an interpreter...; and

a processor coupled to the memory,

the processor configured to use the interpreter to interpret the derivative

Peyret/Renner

see the title and the abstract of the invention and col. 1 lines 53-56.

see fig. 1 and again see the abstract, which indicates that the system uses applets (Java language-derived from a high level language).

Also, see col. 1 lines 4-16 and lines 59-67 and col. 5 lines 59-67. In reference to the converting of the compiled application, the feature appears to have been obvious to a person of ordinary skill in the art at the time of the invention in view of Peyret alone; since, Peyret indicates that applets may all have a common structure, col. 7 lines 53-62. Which infers that they may not all have a common structure and therefore require conversions. However, the feature is considered to be taught by Renner in an analogous art to enable to enable software with different functions and interfacing to communicate, see fig. 4 and Renner's claim 1. Therefore, it would have been obvious to a person of ordinary skill in the art at the time of the invention to enable compatibility between different types of systems, as taught by Renner, to enable compatibility support for new features, see the abstract.

See fig. 2, item 42.

see fig. 1, item 22.

see fig. 2, item 42 and col. 5 lines 36-67.

application for execution.

The applicant indicates that Peyret does not teach the use of Java or any other high level language; however, the features taught by Peyret reads directly on the Java programming language.

For example, Peyret indicates that "the applets run through the interpreter so that the applets do not have any direct access to the hardware of the smart card", col. 5 lines 44-46; while, the Java programming language (see the newly cited reference Writing Java Applets by John Rodley (Chapter 1), cited only to indicate the inherent features of the Java programming language) indicates that applets are accessed via an interpreter for portability and security purposes. These features are taught by Rodley on pages 9-10 and pages 12-13. Therefore, Peyret's system inherently teaches the use of the Java programming language.

Peyret describes the interpreter as a virtual machine having a piece of software that acts as an interface between the hardware processor and the applets (col. 5 lines 36-51.); while, Rodley also indicates that the interpreter is software (different for each CPU and operating system) utilizing the Java Virtual Machine, pages 9-11.

Peyret further indicates that his source code is translated into bytecode, col. 5 lines 59-62; which is also a feature of the Java programming language, see Rodley's page 11.

107. The microcontroller of claim 106, further comprising: a communicator configured to communicate with a terminal. this feature is standard for IC Cards to enable communications between the IC Card and the terminal, see the interface 86 of fig. 4. Note, the IC card contains a microcontroller, see fig. 1 item 22.

108. The microcontroller of claim 108 wherein the terminal has a card reader and the communicator comprises a contact see col. 7 lines 20-32.

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for communicating with the card reader.

109. The microcontroller of claim 108 wherein the terminal has a wireless communicator and a wireless transceiver for communicating with the wireless communication device.

see col. 8 lines 55-61 and col. 9 lines 10-32, which suggests that the smart card can be used to obtain foreign currency (i.e. overseas over a wireless network). See also, col. 7 lines 20-32 (any conventional network... across the world) and col. 8 lines 55-61.

110. The microcontroller of claim 108 wherein the terminal has a wireless communication device and the communicator comprises a wireless transmitter for communicating with the wireless communication device.

see the rejection of claim 109 above.

111. The microcontroller of claim 106, wherein the class file format comprises a Java class file format.

this feature is inherent via the applets, interpreter, virtual machine and the compilations into bytecode, col. 5 lines 36-67. Also, the security features further indicate that the java class file format is used, col. 5 lines 13-35.

The features taught by Peyret read directly on the Java programming language.

For example, Peyret indicates that "the applets run through the interpreter so that the applets do not have any direct access to the hardware of the smart card", col. 5 lines 44-46; while, the Java programming language (see the newly cited reference Writing Java Applets by John Rodley (Chapter 1), cited only to indicate the inherent features of the Java programming language) indicates that applets are accessed via an interpreter for portability and security purposes. These features are taught by Rodley on pages 9-10 and pages 12-13. Therefore, Peyret's system inherently teaches the use of the Java programming language.

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system) utilizing the Java Virtual Machine, pages 9-11.

Peyret further indicates that his source code is translated into bytecode, col. 5 lines 59-62; which is also a feature of the Java programming language, see Rodley's page 11.

Claims 112-113 are rejected as claim 106; with the converter being inherent via col. 1 lines 33-52 and col. 5 lines 48-58.

In reference to claim 114, see the rejection of claim 111.

As per claim 115, the features are inherent to enable updates to specific applets that may be associated with other applets, see col. 6 lines 28-65.

Claim 116 is rejected via col. 7 lines 43-67; which provides for authentication via a PIN number.

The features of claim 117 are inherent in banking systems and telephone access systems to check identity before enabling access to the system, col. 8 lines 1-15.

In reference to claim 118, see the rejections of claims 112-115.

As per claim 120, see col. 3 lines 9-53, which indicates that applications may be removed to enable execution of other applications.

The features of claims 121-123 are inherent Java functions and are therefore rejected via claim 111.

In reference to claims 124-125 and 132, see col. 6 lines 1-27, the cryptographic library provides for access control (permissions) to the system. Also, see col. 5 lines 13-35.

As per claim 126, see the rejection of claim 106.

The features of claims 127-128 are taught via claim 115.

In reference to claims 130-131, see the rejection of claims 118 and 116.

As per claims 133-142, see the rejection of claims 115-117 and 122-125.

The features of claims 143, 145 and 147 are taught via claim 107 in view of col. 1 line 53-col. 2 line

30.

In reference to claim 149, see the rejection of claim 115.

5. Other references (for example, 6,223,984; 5,663,553 and 5,500,517), although not specifically cited, are considered pertinent to the applicant's disclosure.

#### *Allowable Subject Matter*

6. Claims 119, 129, 144, 146, and 148 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

#### *Conclusion*

7. Applicant's arguments with respect to claims 106-118, 120-128, 130-143, 145, 147 and 149 have been considered but are moot in view of the new ground(s) of rejection.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Chavis whose telephone number is (703) 305-9665. The examiner can normally be reached on Monday-Friday from 8:30am to 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kakali Chaki (Art

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**Unit 2124),** can be reached on (703) 305-9662. The fax number for this Group is (703) 746-7240 for non-Official faxes.

Official faxes should be sent to (703) 746-7239 and

After Final faxes should be sent to (703) 746-7238.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-3900.

*JQC*

JQC  
September 20, 2003

*John Chavis*

JOHN CHAVIS  
PATENT EXAMINER  
ART UNIT 2124